

REMARKS/ARGUMENTS

Amendments in General

1. Claims 2-7 and 12 have been canceled.
2. New claims 17 and 18 have been added. These two claims are directed toward the cursor concept disclosed in paragraph [0133]. Such changes add no new matter.
3. Typographical errors in claims 8, 9 and 13 have been corrected. Such changes add no new matter.

Claim Rejections - 35 USC § 102

4. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
5. The Examiner rejected claims 1-3, 5, 8 and 10 under §102(b) as being anticipated by Kobayashi.
6. Claim 1 has been amended to include the limitations of claims 2-7. Kobayashi, as previously noted by the Examiner, does not contain the limitations of claims 4 or 6. As such, Claim 1 is no longer anticipated.
7. As for claim 8 (and claim 10 which depends there-from), the limitation that “wherein said marking portion extends downwards from a position forward of the junction between the base portion and the front portion, where said marking portion is aligned with a cursor, said cursor for allowing said user to visually determine the location at which said mark will be made upon said surface” has been added there-to. Said limitation is supported by paragraph [0133] of the specification. Such changes add no new matter. Claim 8, as amended, is neither anticipated nor is it obvious in view of the prior art.

Claim Rejections - 35 USC § 103(a)

8. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

9. The Examiner rejected claims 4 and 9 under §103(a) as being unpatentable (obvious) over Kobayashi in view of Hollingsworth.

- a. Claim 4 has been canceled.
- b. Claim 9 depends from claim 8 which has been amended (as previously discussed) to include additional limitations (the marking portion extends downwards from a position forward of the junction between the base portion and the front portion and the marking portion is aligned with a cursor, the cursor for allowing said user to visually determine the location at which said mark will be made upon said surface).
- c. Neither Kobayashi nor Hollingsworth include such a limitation. As such, claim 9 is patentable over the references shown.
- d. Additionally, the reason that magnesium is used is non-obvious in that magnesium (and its alloys) is particularly used in this claimed embodiment for its ability to leave a mark on a surface without scratching or otherwise damaging the surface. The mark can then later be rubbed and/or washed off the surface.

10. The Examiner rejected claims 6 and 12 under §103(a) as being unpatentable (obvious) over Kobayashi in view of Carlson.

- a. Claim 6 has been canceled.
- b. Claim 12 has been canceled.
- c. The rejection is thereby moot.

11. The Examiner rejected claims 7, 11, 13 and 15 under §103(a) as being unpatentable (obvious) over Kobayashi in view of Bo.

- a. Non-analogous prior art. Only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will only be analogous art if: 1) it is from the same field of endeavor as the claimed invention; or 2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir. 1992). In the *In re Clay* case, the subject claims were directed to a process that improved removal of oil products from storage tanks. The Examiner in that case cited a patent directed to improving production of oil from underground formations. The Federal Circuit held that the cited patent is not analogous art even though the cited patent and subject application both related to the oil industry.
- b. The Bo reference is not within the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve a problem of marking tape measures would not reasonably be expected or motivated to look to stamping tools used for cold marking. The Bo reference is non-analogous prior art. As such, the rejection of claims 7, 11, 13 and 15 is improper.
- c. Claim 7 has been canceled.
- d. Claim 11 depends from claim 8 which has been amended (as previously discussed) to include additional limitations (the marking portion extends downwards from a position forward of the junction between the base portion and the front portion and the marking portion is aligned with a cursor, the cursor for allowing said user to visually determine the location at which said mark will be made upon said surface). Neither Kobayashi nor Hollingsworth include such a limitation. As such, claim 9 is patentable over the references shown.
- e. Claim 13. The Examiner argues that "it would have been obvious at the time the invention was made ... to use a convex marker as taught by Bo in conjunction with the device of Kobayashi for the purpose of providing an alternative marking shape on the Kobayashi device." However, Kobayashi clearly teaches away from such a combination. Kobayashi teaches a "scratch marker." To scratch, you must

have a point. A concave shape has two points (as shown in Kobayashi). A convex shape does not have a "scratch marker" shape and as such it is impossible for Kobayashi to use a concave shape. The present invention creates accurate marks, and scratching via a hand held tool does not make such smooth marks. Instead, a concave shape must be used to glide or slide the appropriate mark on the surface. As such, the combination does not render the present invention obvious.

- f. Additionally, Bo is used to mechanically stamp the mark on the surface. The act of stamping would require additional manipulation of the measuring device (for instance depressing the stamping mechanism) which would move the marking device off its intended marking place thereby creating inaccuracies in the marking process. As such, the combination does not render the present invention obvious.
- g. Claim 15 depends from claim 13, which as discussed above is non-obvious. As such, claim 15 is non-obvious in view of the prior art.

12. The Examiner rejected claim 14 under §103(a) as being unpatentable (obvious) over Kobayashi in view of Bo as applied to claim 13, and further in view of Hollingsworth.

- a. Claim 14 depends from claim 13. Applicant has previously argued (*supra*) that claim 13 is allowable and as such claim 14 is allowable. Nonetheless, the arguments (*supra*) for why claim 13 is not anticipated/obvious apply to claim 14 as well.

13. The Examiner rejected claim 16 under §103(a) as being unpatentable (obvious) over Kobayashi in view of Bo as applied to claim 13, further in view of Carlson.

- a. Claim 16 depends from claim 13. Applicant has previously argued (*supra*) that claim 13 is allowable and as such claim 16 is allowable. Nonetheless, the arguments (*supra*) for why claim 13 is not anticipated/obvious apply to claim 16 as well.

14. No new matter has been added via amendment in this Response.

Conclusion

For the above reasons, Applicant believes the claims of the present application, as amended, are not anticipated nor are they obvious. If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 21st day of January 2005.

Very respectfully,



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